

U.S. Patent No. 6,388,714 ("Schein") in view of Gerace, U.S. Patent No. 5,848,396 ("Gerace"), "the Schein-Gerace Combination."

Claims 3-5, 8-11, 14-16, 19-22, 25-27, and 30-33 were rejected under 35 U.S.C. § 103(a) as being unpatentable over the Schein-Gerace Combination in further view of Bisdikian et al., U.S. Patent No. 5,974,406 ("Bisdikian"), "the Schein-Gerace-Bisdikian Combination."

Claims 7, 18, and 29 were rejected under 35 U.S.C. § 103(a) as being unpatentable over the Schein-Gerace-Bisdikian Combination in further view of Buhrmann et al., U.S. Patent No. 5,933,778 ("Buhrmann"), "the Schein-Gerace-Bisdikian-Buhrmann Combination."

However, applicants respectfully submit that, for the reasons set forth in detail below, a *prima facie* case of obviousness has not been made and the rejections under § 103 should be withdrawn. See MPEP §§ 2142 and 2143.

A. Claims 1, 2, 12, 13, 23, and 24

Claims 1, 2, 12, 13, 23, and 24 generally relate to systems and methods for providing personalized web pages of information using an on-line scheduling application. As set forth in applicants' independent claims 1, 12, and 23, a user is provided with "an opportunity to select at least one desired television-related information source" and "at least one desired non-television-related information source ... for providing schedule information for non-televised events." The information sources selected by the user provide "a grid of television program listings on the web page" and "a region of non-television-related schedule information on the same web page."

As set forth in detail below, applicants' claims 1, 2, 12, 13, 23, and 24 are allowable over the Schein-Gerace Combination for two independent reasons.

1. The Schein-Gerace Combination Does Not Show Or Suggest All Elements Of Applicants' Claims

The Examiner acknowledges that applicants' systems and methods of claims 1, 12 and 23 are patentable over Schein by "providing the user with an opportunity to select at least one desired non-television-related information source ... for providing schedule information for non-televised events ... **on the same web page** [as the grid of television program listings]" (emphasis added). See page 3 of the Office Action.

The Examiner attempts to show this feature of applicants' claims with the disclosure of Gerace, which generally relates to systems and methods for customizing information provided to a computer user based on the user's activity, behavior, and/or psychographic profile. See Abstract. However, Gerace does not show or suggest allowing users "to **select** at least one desired non-television-related information source" and "providing schedule information for non-televised events ... **on the same web page**" as television program listings, as required by applicants' claims 1, 12, and 23.

Instead, Gerace provides television program listings and non-television schedule information on two or more separate web pages. Gerace shows that City Page Objects may be used to customize a Media Schedule web page according to a user's location, and that the web page may provide access (e.g., web links) to **other** web pages having schedule information for non-televised events. See

column 10, line 59 - column 11, line 4. Although Gerace shows that customized links to other web pages may be provided, the schedule information for non-televised events is not presented in "**the same web page**" as the television program listings, as required by applicants' claims 1, 12, and 23. As set forth in applicants' specification, applicants' approach of presenting television schedule information and schedule information for non-televised events **on the same web page** is preferable because users can reduce the amount of time and effort required to sort through large amounts of unneeded information. See, for example, page 1, line 21 - page 2, line 5.

For at least this reason, the § 103 rejections of claims 1, 12, and 23 should be withdrawn. See In re Royka, 490 F.2d 981, 180 USPQ 580 (CCPA 1974) ("To establish *prima facie* obviousness of a claimed invention, all claim limitations must be taught or suggested by the prior art"); see also MPEP § 2143.03. Dependent claims 2, 13, and 24 are likewise allowable over the Schein-Gerace Combination.* See In re Fine, 837 F.2d 1071, 1074 (Fed. Cir. 1988) ("Dependent claims are non-obvious under 35 U.S.C. § 103 if the independent claims from which they depend are non-obvious").

2. The Office Action Fails To Provide
Sufficient Motivation For Making the
Schein-Gerace Combination

Moreover, the § 103 rejections fail because the Office Action does not provide a sufficient motivation for

* Applicants reserve the right to demonstrate the patentability of claims 2, 13, and 24 based on the claimed features should prosecution of this case continue.

combining the references. See In re Rouffet, 149 F.3d 1350, 1355 ("When a rejection depends on a combination of prior art references, there must be some teaching, suggestion, or motivation to combine the references"). See also MPEP §§ 2142 and 2143.01. Instead, the Office Action merely suggests that it would have been obvious to modify Schein with Gerace to "decreas[e] the time necessary for obtaining wanted information while reducing the amount of received, unwanted information." See page 4 of the Office Action.

However, this motivation is taken from the teaching of applicants' disclosure, not the prior art. See, for example, page 1, line 21 - page 2, line 5. This is improper and does not sufficiently support a rejection based on obviousness. See In re Vaeck, 947 F.2d 488, 493 ("[T]he suggestion [of a motivation to combine the references] ... must be founded in the prior art, not in the applicant's disclosure"). For this additional reason, the § 103 rejections should be withdrawn. See MPEP §§ 2142 and 2143.

B. Claims 3, 4, 14, 15, 25, and 26

Claims 3, 4, 14, 15, 25, and 26 were rejected under 35 U.S.C. § 103(a) as being unpatentable over the Schein-Gerace-Bisdikian Combination. However, applicants have shown that independent claims 1, 12, and 23 are patentable. Accordingly, dependent claims 3, 4, 14, 15, 25, and 26 are also patentable.* See In re Fine at 1074.

* Applicants reserve the right to demonstrate the patentability of claims 2, 13, and 24 based on the claimed features should prosecution of this case continue.

Moreover, these § 103 rejections should be withdrawn because the Office Action fails to provide a sufficient motivation for making the Schein-Gerace-Bisdikian Combination. See In re Rouffet at 1355; see also MPEP §§ 2142 and 2143.01. First, as stated above, the Office Action does not provide a proper motivation for combining Schein and Gerace. Second, instead of providing a sufficient motivation for combining Bisdikian with Schein and Gerace, the Office Action merely concludes that it would have been obvious to make the Schein-Gerace-Bisdikian Combination "because it would allow the user to access the television listings, non-television-related schedule information and notifications by various communication means ... according to the user preference/profile." See page 5 of the Office Action.

This statement of motivation is tantamount to saying that it would have been obvious to combine the references because it would have led to applicants' claimed approach. However, such "[b]road conclusory statements regarding the teaching of multiple references, standing alone, are not 'evidence'" of a motivation to combine the reference. In re Kotzab, 55 USPQ2d 1313, 1317 (Fed. Cir. 2000); In re Dembiczak, 175 F.3d 994, 999 (Fed. Cir. 1999); see also MPEP § 2143. Indeed, because it is based on "subjective belief and unknown authority," this statement does not "adequately address the issue" of providing a sufficient motivation to combine the references. In re Lee, 61 USPQ2d 1430, 1434. Accordingly, the § 103 rejections should be withdrawn. See MPEP §§ 2142 and 2143.

C. Claims 5, 7-11, 16, 18-22, 27, and 29-33

Claims 5, 8-11, 16, 19-22, 27, and 30-33 were rejected under 35 U.S.C. § 103(a) as being unpatentable over the Schein-Gerace-Bisdikian Combination. Claim 7, 18, and 29 were rejected under § 103 as being unpatentable over the Schein-Gerace-Bisdikian-Buhrmann Combination.

The Office Action indicates that independent claims 5, 16, and 27 were rejected using the same rationale as the rejections of independent claims 1, 12, and 23. See pages 5-6 of the Office Action. However, independent claims 1, 12, and 23 were not rejected as being unpatentable over the Schein-Gerace-Bisdikian Combination.* Moreover, applicants have already demonstrated the patentability of claims 1, 12, and 23 and have shown that the Office Action fails to provide an adequate basis for making the Schein-Gerace and Schein-Gerace-Bisdikian Combinations. For at least these reasons, claims 5, 16, and 27 are patentable over the Schein-Gerace-Bisdikian Combination. Claims 7-11, 18-22, and 29-33 are likewise patentable.** See In re Fine at 1074.

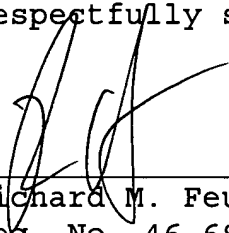
* Bisdikian was not cited in the rejections of independent claims 1, 12, and 23.

** Applicants reserve the right to demonstrate the patentability of claims 5, 7-11, 16, 18-22, 27, and 29-33 based on the claimed features should prosecution of this case continue.

II. Conclusion

The foregoing demonstrates that claims 1-5, 7-16, 18-27, and 29-33 are allowable. This application is therefore in condition for allowance. Reconsideration and allowance of the application are respectfully requested.

Respectfully submitted,



Richard M. Feustel, Jr.
Reg. No. 46,698
Attorney for Applicants
FISH & NEAVE
Customer No. 1473
1251 Avenue of the Americas
New York, New York 10020-1104
Tel.: (212) 596-9000